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STANDLEY LAW GROUP

LLP

Attorneys and Counselors at Law

495 Metro Place South, Suite 210
Dublin, Ohio 43017-5315
Telephone: (614) 792-5555
Facsimile: (614) 792-5536

FACSIMILE COVER SHEET

DATE: June 28, 2006

FACSIMILE NO.: 571-273-8300

TO: Yoon Young Kim

COMPANY: Group Art Unit 1723

FROM: James L. Kwak

Number of pages (including cover sheet) - 6 pages

SUBJECT: 2nd Transmittal of Request for Telephone Interview

NOTES: Please call to schedule interview.

CONFIRMATION: ☐ by First Class Mail
☐ by Express Mail
☒ none

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JUN 28 2006

 PTO/413A (08-04)
 Approved for use through 07/31/2006. OMB 0651-0031
 U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Applicant Initiated Interview Request Form

 Application No.: 10/731,820 First Named Applicant: Guzman
 Examiner: Kim, Yoon Young Art Unit: 1723 Status of Application: Pending
Tentative Participants:

 (1) James Kwak (2) Examiner Kim
 (3) _____ (4) _____

 Proposed Date of Interview: Week of June 19, 2006

Proposed Time: _____ Examiner's Convenience (AM/PM)

Type of Interview Requested:

 (1) ☒ Telephonic (2) ☐ Personal (3) ☐ Video Conference

 Exhibit To Be Shown or Demonstrated: ☐ YES ☒ NO

If yes, provide brief description: _____

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>See attached sheet</u>	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
<input checked="" type="checkbox"/> Continuation Sheet Attached					

Brief Description of Arguments to be Presented:
See attached sheet

An interview was conducted on the above-identified application on _____.

NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Applicant's Representative Signature

James L. Kwak

Typed/Printed Name of Applicant or Representative

41,133

Examiner/SPE Signature

Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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JUN 28 2006

Continuation Sheet for PTOL-413A: Interview Request Form

Application No.: 10/731,820
Inventor: Guzman
Examiner: Kim, Yoon Young

Issues to Be Discussed:

In Applicant's previously filed amendment, the independent claims were amended to include the limitation that the water filter cartridge (18) is attached to the pivotable element (22) so that the water filter cartridge is connected to the water pipe by said pivotable element during use. Nothing in the prior art, including the Farley reference cited by the Examiner, teaches or suggests a filter where the water filter cartridge is directly attached to the pivotable element and the water pipe. In this unique configuration, the replaceable water filter cartridge will not fall out of the filter when the face portion (16) is removed. In fact, this limitation was the key distinction Applicant made over the Farley reference in the filed application (see Background and Summary of the Invention portion of the application).

The Examiner, in the final rejection, concedes that the Farley reference, relied upon by the Examiner, does not disclose that the water filter cartridge is attached to the pivotable element. However, the Examiner then rejects the claims stating that the use of a "one-piece construction instead of the structure disclosed would be merely a matter of obvious engineering choice" citing the case of In re Larson, 340 F.2d 965 (CCPA 1965).

Applicant respectfully traverses the Examiner's final rejection based on the following reasons:

1. Applicant's invention is not merely an obvious design choice. The Examiner's reliance on the In re Larson decision is improper as the holding in that case is not dispositive to the facts in this case. Applicant's invention is not simply a case of making something one-piece that was previously disclosed as being several separate parts attached together (in fact, in Farley, the interior filter cartridge is not attached to other components at all). In the present case, the attachment to the pivotable element (and the water pipe) is completely moved from the outer body of the filter (Farley) to the interior water filter cartridge. See In re Chu, 66 F.3d 292, 298 (Fed. Cir. 1995) (finding that placing the catalyst within the bag retainer was not a matter of design choice in view of the prior art which taught the situating of the catalyst between two filter bags). Applicant had to reconfigure the filter cartridge and filter body to allow attachment of the pivotable inlet to the interior cartridge and water pipe while allowing the cartridge to be removable and disposable. These changes amount to more than a mere "design change" as evidence by the fact it has never been done before prior to Applicant's invention.
2. A prima facie case of obviousness has not been established as nothing in the prior art or the general knowledge in field teaches or suggests a filter where the filter cartridge is adapted to be attached

mechanically to the pivotable element and the water pipe coming out of a shower wall. In the prior art filters, including Farley, the disposable water filter cartridge is merely housed loosely inside the filter body without any mechanical attachment to the pivotable element or water pipe. In all of these references the mechanical attachment to the pivotable element and water pipe is on the outer body of the filter and not on the filter cartridge located inside the filter body. The location of the mechanical attachment in the present invention is crucial as it secures the water filter cartridge to the pipe in the wall even when the body of the filter is removed (cartridge will not fall out and hurt the user in the shower). To maintain this rejection, the Examiner must provide concrete documentary evidence or a personal affidavit demonstrating that it was generally known to attach a water filter cartridge directly to a pivotable element and wall pipe. See M.P.E.P. 2144.03.

3. The Examiner's proposed modification of Farley to "make the baffle element integral with the filter cartridge" would lead to a device inoperable for its intended purpose and therefore such modification teaches away from the claimed combination. A stated purpose of Farley is to provide a "single body. . .easily disassembled to replace or remove the water filter held therein. . ." Farley patent, col. 1, ll. 59-61. In other words, in Farley, attaching the baffle element with the filter cartridge would result in a filter cartridge attached to the body portion

that could not be removed and replaced. Tec Air, Inc. v. Denso Manufacturing Michigan, Inc., 192 F.3d 1353 (Fed. Cir. 1999) (holding that if references taken in combination would produce an device inoperable for its intended purpose, such references teach away from the combination and cannot serve as a prima facie case of obviousness).

4. The Examiner's rejection based on Farley is improper as it requires substantial reconstruction of the device in Farley to arrive at the claimed invention. In re Ratti, 270 F.2d 810 (CCPA 1959). In order for the water filter cartridge of Farley to be directly connected to the pivotable element, the baffle element would have to be removed from the top body half (22) and reconfigured and attached to the filter cartridge (38). An opening would then have to be cut in the top body half (22) to expose the pivotable element. Such a redesign is only made obvious through hindsight and the benefit of Applicant's disclosure.